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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,574	08/13/2001	Isao Nagata	FA-0824	2531

7590

06/25/2003

E I du Pont de Nemours and company
Legal Patents
Wilmington, DE 19898

EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 06/25/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,574

Applicant(s)

NAGATA ET AL.

Examiner

Rabon Sergent

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-14,16-21 and 24-38 is/are rejected.
- 7) ☒ Claim(s) 8,15,22 and 23 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 4, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

Art Unit: 1711

1. This application does not contain an abstract of the disclosure as required by 37 CFR

1.72(b). An abstract on a separate sheet is required.

2. Claims 8, 15, 22, and 23 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim.

See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

3. Claims 1-7, 9-14, 16-21, and 24-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language, “low VOC”, is subjective, because it is unclear with respect to what quantity of VOC the language provides for.

Within claim 12, it is unclear what is meant by “a non-aqueous dispersion resin, stabilized dispersed polymer particles”. It is unclear if the language is specifying two separate components.

Within claim 19, the language, “light stabilizers of a combination thereof”.

Furthermore, the language, “acid resistant”, within claim 30 is subjective and fails to further define the claim, because virtually any coating has a level of acid resistance.

4. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The subject matter of claim 35 fails to further limit claim 34.

Art Unit: 1711

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 2, 9-14, 16-21, and 24-38 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/34905.

The reference discloses high-solids coating compositions, suitable for use as clearcoats, comprising a polyepoxide and polyacid crosslinking agent, a melamine crosslinking agent, a

Art Unit: 1711

blocked polyisocyanate, and additional polyols, such as polycarbonate polyols. See abstract and pages 2-16.

7. Claims 1, 2, 13, 16-18, 21, 24, and 33-38 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 6-256714.

The reference discloses coating compositions comprising an epoxy resin, a melamine resin, and a blocked polyisocyanate, wherein the components are used in amounts that overlap those claimed by applicants. See abstract and descriptions of components B), C), and D).

8. Claims 1, 2, 13, 14, 16-18, 21, 24-30, and 33-38 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 179,281.

The reference discloses sprayable coating compositions comprising an oligomeric reaction product of an epoxy compound and a carboxylic acid compound, a blocked polyisocyanate, and a melamine resin crosslinking agent. See pages 2-4.

9. Claims 1-5, 9, 11, 13, 16-18, 21, 24-30, and 33-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Holubka et al. ('086).

Patentees disclose high-solids coating compositions comprising a polyol derived from the reaction of a polyepoxide and a polyol, a blocked polyisocyanate, and a melamine resin crosslinking agent. See abstract and columns 3-10.

10. Claims 3, 5, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/34905 or JP 6-256714 or EP 179,281 or Holubka et al. ('086), each in view of December et al. ('469) and Antonelli et al. ('480).

Art Unit: 1711

As aforementioned within paragraphs 6-9, the primary references disclose coating compositions comprising an epoxy component, a melamine component, and a blocked polyisocyanate component; however, the references are largely silent with respect to the use of the applicants' claimed acid catalysts, especially the blocked acid catalysts, and applicants' claimed polymer particles. Still, the use of acid catalysts, including those blocked with amines, to promote the curing of compositions utilizing melamine curing agents and the incorporation of polymer particles into coatings to control sag was known at the time of invention. See column 1, lines 33-40 within December et al. and abstract of Antonelli et al. The position is taken that it would have been obvious to incorporate these conventional components into the instant coating composition, because it has been held that it is obvious to utilize a known component for its known function, and one of ordinary skill in the art would have expected the coating to benefit from their inclusion.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent

June 22, 2003